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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,518

06/05/2006

Rupert Katritzky

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8791

7590

04/11/2011

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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

PAPER NUMBER

1745

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,518	<b>Applicant(s)</b> KATRITZKY ET AL.	
	<b>Examiner</b> KIMBERLY K. MCCLELLAND	<b>Art Unit</b> 1745	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,76,78,80,81 and 129-131 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,76,78,80,81 and 129-131 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/18/11</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

### ***Drawings***

In light of the current amendment, the previous objection to the drawings is withdrawn.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. In light of the current amendment, the rejections of claims 1 and 74-81 under 35 U.S.C. 103 (a) have been withdrawn.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1 and 76, 78, 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,672,356 to Jenkins et al. in view of U.S. Patent No. 6,036,812 to Williams et al. and U.S. Patent No. 5,209,808 to Booth.

5. With respect to claim 1, Jenkins et al. discloses a labeling system, including a feeder (10/12/20/28/30), said feeder being arranged to deliver said pack to a labeling station (38), wherein the labeling station is arranged to position and orient the pack and the label applicator relative to one another, and wherein said labeling station comprises a label printer (122) arranged to print a label comprising information specific to a patient for whom said pack is intended, a label applicator (138) to apply said label to said pack, wherein the label applicator is arranged to apply the label on the pack, such that the label applicator is able to apply the label to the pack such that one or more of the position of the label on the pack, the orientation of the label relative to the pack, or the number of planes of the pack to which the label is applied is variable (column 9, lines 44-47; See Figures 1-8); a computer (44) to enter an order for a pack and to pass information to the labeling station to allow the label applicator to determine the position, orientation, and number of planes at which to apply the label, dependent upon the dimensions of the pack to be labelled; and the system further comprising a delivery subsystem (20/28) to deliver said pack from the labeling station so as to be accessible to a user (column 5, lines 2-17). Jenkins et al. does not specifically disclose the feeder is a robot arm or the label applicator is able to apply the label in at least two discrete planes.

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6. Williams et al. discloses a pill dispensing system, including the use of a robot arm as a feeder (column 3, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the robot arm of Williams et al. with the feeder of Jenkins et al. The motivation would have been to allow selective feeding of individual containers (column 3, lines 60-65).

7. Booth discloses a label applicator, including a label applicator able to apply the label in at least two discrete planes (See abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the corner surface label applicator taught by Booth with the device of Jenkins. The motivation would have been to allow the information printed on the label to be read after labeling during handling on a sufficient number of package faces (column 2, lines 10-15).

8. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the pharmaceutical packs and labels are not structurally limiting to the currently claimed apparatus.

9. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner

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in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

10. As to claim 76, Jenkins et al. discloses the label applicator (138) is rotatable to adjust the label applicator’s orientation (Figures 5a-5b).

11. As to claim 78, Jenkins et al. discloses the label applicator is arranged to apply the label at a predetermined position on the pack (column 5, lines 2-17; column 9, lines 44-47). The phrase “the position being variable from one pack type to another” is drawn to the contents of the apparatus and does not structurally contribute to the currently claimed apparatus.

12. As to claim 80, Jenkins et al. discloses the apparatus further comprising a remote computer (44) to pass label positioning information directly to the labeling station or label applicator (column 9, lines 44-54).

13. As to claim 81, Jenkins et al. discloses the apparatus includes labels of common size for application to all packs (See Figures 2 and 2A).

14. Claims 129-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,672,356 to Jenkins et al. in view of U.S. Patent No. 6,036,812 to Williams et al. and U.S. Patent No. 5,209,808 to Booth as applied to claims 1, 76, 78, and 80-81 above, and further in view of U.S. Patent No. 5,798,020 to Coughlin et al.

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15. With respect to claim 129, Jenkins does not specifically disclose the label applicator comprises a main shaft which is able to be translated in two directions.

16. Coughlin discloses a labeler, including the label applicator comprises a main shaft which is able to be translated in two directions. (90) which is able to be translated in two directions (column 3, lines 13-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the moveable shaft of Coughlin with the labeler of Jenkins. The motivation would have been to allow for gentle positioning of the labeler against the article to be labeled (column 3, lines 25-28).

17. As to claim 130, Jenkins does not specifically disclose the two directions are orthogonal.

18. Coughlin discloses a labeler, including the two directions are orthogonal (Figures 4-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the moveable shaft of Coughlin with the labeler of Jenkins. The motivation would have been to allow for gentle positioning of the labeler against the article to be labeled (column 3, lines 25-28).

19. As to claim 131, Jenkins does not specifically disclose the label applicator comprises a main shaft and a pair of rollers hingedly mounted to the main shaft.

20. Coughlin discloses a labeler, including the label applicator comprises a main shaft (90) and a pair of rollers (68; 78) hingedly mounted to the main shaft (Figures 4-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the moveable shaft with rollers of Coughlin with the labeler of

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Jenkins. The motivation would have been to allow for gentle positioning of the labeler against the article to be labeled (column 3, lines 25-28).

### ***Response to Arguments***

21. Applicant's arguments with respect to claims 1, 76, 78, 80-81, and 129-131 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

22. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

23. Examiner notes applicant argues that the phrase, "is able to apply the label to the pack such that one or more of the position of the label on the pack, the orientation of the label relative to the pack, or the number of planes of the pack to which the label is applied, is dependent upon the dimensions of the pack to be labeled" is structural, not functional. However, examiner notes no structure is disclosed in this phrase.

Furthermore, applicant has specifically stated, "These features of the labelling station, label applicator, and computer provide structural elements which enable the application of the label dependent upon the dimension of the pack to be labelled" (remarks filed 1/20/11, page 6). Therefore, applicant has asserted no further structural features are required to perform the intended function of the apparatus. Applicant has failed to identify any physical structure required by this claim language, but instead asserts that its intended operation is different from that of the prior art. Examiner notes the phrase is

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entirely drawn to the intended functional use of the apparatus. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Consequently, this argument is not persuasive.

### ***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/  
Examiner, Art Unit 1791

KKM